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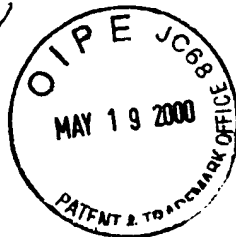
Rejection under 37CFR 1.144, 1.181 & 1.182

Applicant(s): DANIEL A. GATELY

Title: Silylated & N-silylated Compound Synthesis

Serial No.: 09/016,641

Filing Date: 1/30/58



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :  
DANIEL A. GATELY : Art Unit 1621  
Serial No. 09/016,641 :  
Filed January 30, 1998 :  
FOR: SILYLATED AND N-SILYLATED : Examiner: J. Vollano  
COMPOUND SYNTHESIS :

PETITION UNDER 37 C.F.R. §§1.144,  
1.181(a)(1) AND (3) AND 1.182

Honorable Commissioner of  
Patents and Trademarks  
Washington, D. C. 20231

Sir:

This Petition invokes the supervisory authority of the  
Commissioner

- (1) to order the examiner to enter the "Third 37 C.F.R.  
§1.116 Response" and to examine, on the merits, each  
involved claim as it appears if the said Response is  
entered, as it should be—all notwithstanding the  
May 5, 2000 action, Paper No. 23, which says the  
"amendment [Third Response] will not be entered"; and
- (2) suspend proceedings in this application pending  
disposition of this Petition, the Renewed Petition  
filed March 10, 2000, and the Supplement to the Renewed  
Petition filed May 1, 2000.<sup>1</sup>

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<sup>1</sup> This Petition involves some of the same issues and,  
therefore, is best considered concurrently with the "Supplement  
to 'Renewed Petition Under 37 C.F.R. §1.144' filed March 10,  
2000" faxed to the examiner on May 1, 2000 See page 4.

### THE ISSUES

1. Paper No. 23 mailed May 5, 2000 states that the proposed amendment (set forth in the "response to final rejection, filed on May 22, 1900 [sic]", i.e., the Third Response filed May 1, 2000) "will not be entered because":

- (a) [T]hey raise new issues that would require further consideration and/or search. (See note below).

NOTE: The addition of the amendment would present [unidentified] 35 USC 112 problems since claim 3 would be dependent on a canceled claim [1]. Also the amendment cancels all active claims.

- (2) Other The examiner had not "unconditionally" agreed to rejoin the claims after a final rejection was made....

The "NOTE" refers to so much of the Third Response as states:

#### Purpose of this Third Response

Shortly stated, as the Interview Summary states, counsel at the April 17, 2000 interview agreed to "cancel...all nitrogen directed claims". Inadvertently, and contrary to that April 17, 2000 agreement, the Amendment submitted April 19, 2000 cancelled "all non-nitrogen claims". That Amendment was not entered. The Examiner brought this error to counsel's attention by telephone interview on April 24, 2000.

The purpose of this Third Response is to comply with the agreement made April 17, 2000.

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#### REMARKS

It is believed that this Amendment "cancels all nitrogen directed claims" as counsel agreed on April 17, 2000. If the Examiner disagrees in any respect, she is authorized and requested to make the necessary changes by examiner's amendment. The Examiner is now requested to "rejoin all non nitrogen claims both process + compound", as she unconditionally "agreed" to do on April 17, 2000 (see "Interview Summary"). [Emphasis in original]

Notwithstanding Paper No. 23 mailed May 5, 2000, the issue actually presented by the proposed amendment is whether prosecution of this application should be reopened for examination of "all non-nitrogen claims both process + compound" (i.e., the claims which will be pending if the aforesaid "Third Response" is entered) because the requirement for restriction within claims, which raised the "rejoin" issue, is invalid ab initio.

More particularly, the issues are whether such claims are properly subject to the dubious restriction within claims requirement originally set forth in the first Office action mailed January 7, 1999 and whether the examiner's resort to such dubious restriction requirement as an expedient to comply with examination time limitations imposed by the Patent Office is appropriate. In other words, the issue is not merely whether the examiner agreed to rejoin these claims at an April 17, 2000 interview, and then changed her mind (which she surely did), but

instead whether the relevant part of the original restriction requirement (a requirement for restriction within claims) was proper in the first place in view of "The Additional Reason" set forth in the "Supplement", i.e.,

#### The Additional Reason

The Examiner interviews and related documents indicate that:

1. The Examiner and apparently other examiners have encountered serious problems in connection with this application and others in the preparation, within the limited time allowed by Patent Office unpublished regulations (understood to be 90 minutes), of a "complete" action as required by 37 C.F.R. §1.104(b).

2. The aforesaid problem is acute in the context of applications which include many claims set forth in a large number of pages and of applications which contain claims directed to Markush groups having a large number of members.

3. To solve the problem, the Examiner in this case (in what may be uniform practice in Art Unit 1621) resorted to a requirement for restriction within claims postulated on a strained argument that "independent and distinct inventions are claimed" (Rule 1.142) within the claims presented. It is that restriction requirement which resulted in all of the petition proceedings in this case.

#### STATEMENT OF FACTS

As stated in the "Supplement" and reiterated with emphasis here:

The "Renewed Petition" was timely filed on March 20, 2000. On April 14, 2000 (Friday), the Examiner called counsel to discuss "recombining" some of the claims subject to the disputed "restriction within claims" requirement, which is the subject of the Renewed Petition. The Examiner

stated, in substance, that the Renewed Petition was due to be "sent forward" by Monday, April 17, 2000 and that if "sent forward", disposition of the petition would be long delayed, perhaps by more than one year. The Examiner suggested withdrawal of the Renewed Petition if agreement was reached to recombine some of the claims involved in the restriction requirement. Because the matter was difficult to resolve by telephone, it was agreed to have a personal interview on Monday, April 17, 2000, which was done.

At the outset of the interview, counsel stated that he would not agree to restriction within a claim. The Examiner, in response, summarized the "problem" above set forth which, it is understood, motivated a "restriction within a claim" practice. The Examiner again mentioned the delay which would result if the Petition were "sent forward" to the supervisory authority for disposition. The Examiner did not, however, want to establish a precedent which might preclude restriction within a claim. The interview proceeded from that point.

The result of the interview is correctly set forth in the April 17, 2000 "Interview Summary" [written by the examiner in her own hand] as follows:

The examiner has agreed to rejoin all non-nitrogen claims both process + compounds if applicant cancels all nitrogen directed claims. Applicant proposes withdrawing petition for speedy prosecution.<sup>1</sup> The amendment if presented must be filed timely. [Emphasis added.]

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<sup>1</sup> Applicant's motivation for a proposed withdrawal of the petition was not limited to "speedy prosecution", but also included a desire to accommodate the Examiner's wish to avoid precedent which would compromise or preclude restriction within claims.

At 12:30 p.m. on Wednesday, April 19, 2000, applicant transmitted by fax to the Examiner a "Second 37 C.F.R. §1.116 Response".... The Examiner, pursuant to her request, was concurrently advised by telephone that the fax had been sent. Through inadvertence, the "Second Response" did not

purport to cancel "all nitrogen directed claims", as agreed at the April 17, 2000 interview, but instead purported incorrectly to cancel all non-nitrogen claims, i.e., claims subject to the proposed rejoinder. Notably, this error is clearly set forth on the first page of the Second Response (which the Examiner received shortly after transmittal on April 19, 2000 upon telephone notification that the fax had been sent—all pursuant to her request), which states:

This second 37 C.F.R. §1.116 Response is filed to implement the agreement noted by the April 17, 2000 "Interview Summary".

I.

It is the intent of this amendment to cancel all non-nitrogen claims, both process and compounds....  
[page 1]

Appropriately because of this error, the Second Response was not entered. A "Third Response" which does cancel "all nitrogen directed claims" was faxed to the Examiner on Monday, May 1, 2000.

It is that "Third Response" which is the subject of this  
Petition. The "Remarks" portion of that Third Response states in its second paragraph:

By telephone interview [initiated by the examiner] on April 24, 2000, the Examiner purported to redact that agreement, in part. See April 24, 2000 "Interview Summary". (Non-nitrogen claims will be rejoined and an amendment entered "only if the amendment places this application in condition for allowance" and only if the "petition is withdrawn.).... [Emphasis added.]

The "only if" statement in the April 24, 2000 interview summary clashes directly with the April 17, 2000 interview

summary which includes no such "only if" condition or qualification.

The counsel's statement in the Third Response as to what the examiner "unconditionally 'agreed' to do on April 17, 2000" accords with:

- (1) The April 17, 2000 interview summary, which the examiner herself wrote and which states, without any condition, that "[t]he examiner has agreed to rejoin all non nitrogen claims both process + compounds if applicant cancels all nitrogen directed claims".
- (2) The attached Exhibit A which is a copy of claims from the corresponding PCT/US99/02007 case. This Exhibit A was specifically discussed at the April 17, 2000 interview. The handwriting on Exhibit A is all that of Examiner Vollano. Please note the unqualified "will examine" statements in her own handwriting appear after claim 1 (in part), claim 2, claim 3 and claim 4.<sup>2</sup>

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<sup>2</sup> Specifically, the "will examine" statement is not qualified by an assertion that the examination will be conducted only if the amendment does not require reopening of prosecution and only if the "petition is withdrawn". The examiner's April 24, 2000 telephone interview summary goes on to state: "This [rejoinder] was offered completely as a courtesy to applicant". As noted, however, it apparently was motivated, in part, by the examiner's desire to avoid a ruling on the "restriction within a claim" practice and for "The Additional Reason" set forth in the Supplement.



The reasons stated in Paper No. 23 for non-entry of the "Third Response" exist because—and only because—it fully complies with the agreement reported by the April 17, 2000 interview summary. The examiner should be required to honor her part of that April 17, 2000 agreement.

AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

Any fee due may be charged to Deposit Account 09-0948.



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Dated: May 19, 2000

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## I CLAIM:

1. A compound having the formula I



or the formula II



in which X is H or F, each Q in formula (I) may be the same or a different alkyl or aryl hydrocarbyl group with the proviso that when X is F in formula (I), Q is not methyl, and Z is an alkyl or aryl hydrocarbyl group which may be the same or different from Q.

2. A claim 1 compound in which each Q is an alkyl group having one to eight carbon atoms.
- will examine*

3. A claim 1 compound in which X is H and Z is a tertiary butyl group.
- will examine*

4. The compound
- $(CH_3SO_3)_2Si(CH_3)_2 \cdot 0.5HCl$
- .
- will examine*

5. The compound
- $(CF_3SO_3)_2Si(CH_3)_2$



6. The compound
- $(CH_3SO_3)_2Si(CH_3)_2$



7. A method for preparing a silylated or N-silylated mono- or bis- cyclopentadienyl or indenyl compound which comprises reacting a lithiated mono or bis cyclopentadienyl or indenyl compound with a claim 1 compound of Formula I or Formula II. *DELETE*

8. A method for preparing an N-silylated mono- or bis- cyclopentadienyl or indenyl compound which comprises *delete*

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please call

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reacting a lithiated mono- or bis- cyclopentadienyl or indenyl compound with a claim 6 compound.

9. A method which comprises:

- 5 (i) reacting a compound including a -CH group with a compound having the formula RM in which R is any hydrocarbyl group and M is an alkali metal in a non-interfering solvent wherein a reaction mixture containing a compound having a -CM group in said solvent is produced;
- 10 (ii) reacting a metallocene ligand with said compound having the formula -CM produced in step (i) wherein a reaction mixture containing an alkali metallide of said metallocene ligand is produced; and
- 15 (iii) reacting said alkali metallide of said metallocene ligand with a compound of Formula (I) or Formula (II).

10. The claim 9 method wherein said step (i) compound RM is an alkyl lithium compound.

11. The claim 9 or claim 10 method wherein said step (iii) is performed by adding said formula (I) or formula (II) compound to said step (ii) reaction mixture.
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12. The claim 9 or claim 10 method further comprising a step (ii) (a), wherein said alkali metallide is separated from said step (ii) reaction mixture prior to step (iii).

13. The claim 9 or claim 10 method wherein said step (ii) metallocene ligand is
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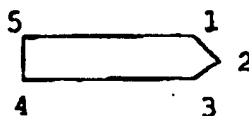
(i) a monocyclopentadienyl ligand having the formulae  $C_5H_xR_y$ , wherein:

X = 0-5

y = 0-5

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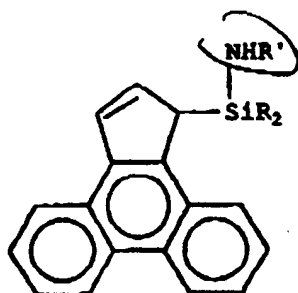
R = any aryl or aromatic group and H or R can occupy any of the positions 1 to 5 of the formula



or

- 5 (ii) a silylated monocyclopentadienyl ligand having the formulae  $(R_2Si)_2C_5H_2R$ , wherein  $C_5H_2R$  is as defined in definition 5,  $Z=1-5$  and R and R' are identical or different alkyl or aromatic groups.

14. A compound having the formula



- 10 in which R and R<sup>1</sup> are the same or different alkyl or aromatic groups.

15. A claim 14 compound in which R<sup>1</sup> is a t-butyl group.